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Paper No. 7

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MAY 09 2002

OFFICE OF PETITIONS

In re Application of :
John A. Nix et al :
Application No. 09/872,904 :
Filed: May 31, 2001 :
Attorney Docket No. MBH00-581 :
: DECISION REFUSING TO ACCORD
: STATUS UNDER 37 CFR 1.47(a)

This is in response to the petition Under 37 CFR 1.47(a), filed February 4, 2002.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the nonsigning inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the nonsigning inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the nonsigning inventor. Applicant lacks items (1) and (2) set forth above.

As to item (1), declarant John A. Nix, Jr., an officer of Go2Call.com, Inc., indicates that Mr. Wiles was contacted on "at least three instances, through mailed correspondence, electronic mail, and/or telephone communications." However, no evidence has been submitted as to what was actually mailed to Mr. Wiles or as to whether the mailing ever reached the intended addressee. Was a complete copy of the application papers (specification, claims, drawings, declaration) mailed to nonsigning inventor Wiles? See MPEP 409.03(d). Before a refusal can be alleged, it must be demonstrated that a complete copy of the application papers was

presented to Mr. Wiles. Otherwise, Mr. Wiles could not attest that he has "reviewed and understands the application papers" and therefore could not sign the declaration which he was given. Unless petitioner can show that a copy of the application papers was presented to Mr. Wiles, then petitioner will have to mail a copy of the complete application papers to Mr. Wiles' last known address, return receipt requested. A cover letter of instructions should accompany the mailing of the application papers setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct.

As to the statement by Mr. Nix that an electronic mail was sent to Mr. Wiles, no evidence of this transmission and the substance thereof has been submitted to support this statement. Additionally, the record fails to state the substance of the telephone communication(s) to Mr. Wiles or as to who made the telephone communication(s) to Mr. Wiles. The substance and results of the electronic mail transmission(s) and the telephone communication(s) must be stated and made by the person having firsthand knowledge thereof.

Where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration by the party to whom the refusal was made. Where there is a written refusal, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the rule 47 applicant that an omitted inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Whenever an omitted inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

As to item (2), the declaration and power of attorney submitted with the petition is not in compliance with 37 CFR 1.63 and 1.64. The declaration fails to set forth inventor Wiles' citizenship, residence and mailing address. Therefore, a declaration in compliance with 37 CFR 1.63 and 1.64 signed by the signing inventors on behalf of the nonsigning inventor is required. See MPEP 409.03(a); MPEP 602 and MPEP 605.01.

In order to expedite consideration of the petition under 37 CFR 1.47(a), petitioner may wish to consider submitting the renewed petition by facsimile transmission to the telephone number indicated below and to the attention of Wan Laymon.

Further correspondence with respect to this matter should be addressed as follows:

By mail: U.S. Patent and Trademark Office
Mail Stop DAC, P.O. Box 2327
Arlington, VA 22202

OR

Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to Wan Laymon at (703) 306-5685.



Frances Hicks
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for Patent Examination Policy